

**REMARKS**

In accordance with the foregoing, the specification has been amended to improve form. Claim 7 has been amended, and claims 1-20 are pending and under consideration. No new matter is presented in this Amendment.

Applicants request entry of this Rule 116 Response because the amendment of the specification and claim 7 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and the amendment does not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**OBJECTION TO THE SPECIFICATION:**

On Pages 2-3 of the Office Action, the Examiner objects to the specification. In light of the amendment to the specification set forth above, it is respectfully requested that the objection be withdrawn.

**REJECTIONS UNDER 35 U.S.C. §112:**

On page 3 of the Office Action, the Examiner rejects claim 7 under 35 U.S.C. §112, second paragraph, as being indefinite. The rejection is respectfully traversed, and reconsideration is requested.

While applicants do not necessarily agree that the Examiner has provided sufficient evidence to maintain the rejection since the Examiner's search appears to be for a phrase "dry wound filter" as opposed to terms "dry" in conjunction with "wound filter", claim 7 has been

amended to remove the term "dry" as indicated and consistent with the Examiner's interpretation. As such, it is respectfully submitted that the amendment presents no new issues, and that the Examiner reconsider and withdraw the rejection.

**REJECTIONS UNDER 35 U.S.C. §102:**

On pages 4-5 of the Office Action, the Examiner rejects claims 1-3 under 35 U.S.C. §102(b) as being anticipated by Yamamoto (U.S. Patent No. 6,279,587). The rejection is respectfully traversed and reconsideration is requested.

By way of review, Yamamoto discloses two parts washers: a parts washer 10 shown in FIG. 1, and another parts washer 120 shown in FIG. 2. The parts washer 10 includes a basin 12 connected to a container 20, which holds a solvent 22. A pump 38 pumps the solvent 22 out of the container 20, through a strainer 32, and the strained solvent 22 is pumped into the basin 12. However, there is no suggestion of another filter, or that a solvent recycling unit having such a filter is used.

In contrast, the parts washer 120 shown in FIG. 2 includes a recycling apparatus 122 which is designed to operate while the parts washer 120 is operating. As such, the parts washer 120 shown in FIG. 2 does not include the strainer 32 shown in the parts washer 10 shown in FIG. 1. (Col. 5, lines 39-45). Therefore, where the recycling apparatus 122 is used, there is no suggestion that the strainer 32 is also used.

On page 15 of the Office Action, the Examiner acknowledges that FIG. 2 does not show such a filter, but asserts, without support, that the one "of ordinary skill in the art would instantly envisage that the strainer 32 is also needed in FIG. 2, whether or not the individual draws it." However, the Examiner has not provided support as to why the strainer 32, while shown in FIG. 1 and not shown in FIG. 2, is necessarily present in the device shown in FIG. 2, which is a device other than the device in FIG. 1.

Indeed, Yamamoto specifically states that "FIG. 2 is an elevational view similar to FIG. 1 but showing some modifications to the embodiment shown in FIG. 1." (Col. 2, lines 17-19). Further, Yamamoto also notes that like part numbers in FIG. 2 "indicate parts or components that are similar to those of the embodiment shown in FIG. 1." (Col. 5, lines 1-5). As such, Yamamoto describes these as separate devices with different components, and that only where the same references numbers are used are the parts the same. Therefore, the omission of the

strainer 32 in FIG. 2 does not indicate a mere failure to draw the strainer 32, but would be understood to be one of the modifications that separate the device in FIG. 1 from the modified device in FIG. 2 and represents a distinction between when a recycling apparatus 122 is used as compared to when one is not present as in FIG. 1.

Moreover, it is noted that other like technologies which incorporate a paint removal mechanism, such as Ihringer (U.S. Patent No. 4,407,316) relied upon by the Examiner below, do not utilize separate filters when a mechanism exists (such as the shown distillation column 8) to remove paint. Indeed, it is noted that the Therefore, there is no inherent need for such a secondary filter in Yamamoto when the recycler 122 is utilized since other devices having such a mechanism do not utilize more than one filter in a manner asserted by the Examiner such that there is evidence supporting why no second filter is shown or described in the device shown in FIG. 2 of Yamamoto as compared to the device shown in FIG. 1 of Yamamoto. With such conflicting information, it is respectfully submitted that there is insufficient evidence that the second filter would be inherently used in the device of FIG. 2.

In general, where the Examiner is relying on a feature as being inherently disclosed in a reference, it is incumbent on the Examiner to provide evidence that such a feature necessarily exists in the reference. In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999), Manual of Patent Examination Procedures 2112. This burden of proof is consistent with the requirement that the Examiner provide sufficient evidence that each and every element is disclosed in a combination as is required to make a prima facie rejection under 35 U.S.C. §103. Manual of Patent Examination Procedures 2143. Since the Examiner has not provided either objective evidence or a cogent technical explanation for the necessary use of a filter in the location corresponding to the location in claim 1, it is respectfully submitted that the Examiner has not provided sufficient evidence to maintain the rejection.

In contrast, claim 1 recites, among other features, "a washing system which is connected to the reservoir and to the basin such that the solvent from the reservoir is moved past a first filter to remove portions of the paint and/or the related spray coatings in the solvent" and "a recycling system which is connected to the reservoir and to the basin such that the solvent from the reservoir is moved past a second filter to remove portions of the paint and/or the related spray coatings in the solvent." As such, it is respectfully submitted that Yamamoto does not disclose or suggest the invention of claim 1.

Lastly, Yamamoto discloses that the solvent 22 can be petroleum or water based.

However, there is no suggestion as to the type of solvent, whether the solvent is both aqueous based as well as having other properties, or that the solvent is biodegradable. On page 16 of the Office Action, the Examiner clarifies that the type of solvent relates to merely an intended use of recited invention. As such, the Examiner again asserts, without support, that since Yamamoto may be capable of handling such solvents, Yamamoto does not need to specifically disclose the type of solvents 22 actually in the device.

On page 16 of the Office Action, the Examiner clarifies that the type of solvent relates to merely an intended use of recited invention. However, claims 2 and 3 are not recited as an intended use but positively recite the solution as an element of the claim. As such, the holdings of cases such as *Ex Parte Masham*, 2 USPQ2d 1647 (BPAI 1987) are not applicable since these holdings relate to claim elements which are not positively defined in the body of the claim. For instance, in *Ex Parte Masham*, the limitation being relied upon by the applicant was recited in the preamble, which the Board held merely set the environment for the positively recited device in the body of the claim. In contrast, claim 2 depends from claim 1 and thus positively recites "a reservoir connected to the basin and which holds a solvent which removes the paint and/or the related spray coatings from the coated article," where "the solvent comprises an aqueous, Hazardous Pollutants (HAPs) free, low VOCs (volatile organic compounds), non-flammable, non-toxic, non-carcinogenic, solvent." The solvent is not recited in a wherein clause or in the preamble, and claim 2 does not recite that the reservoir is merely capable of holding such as solvent, but positively recites the solvent as an element of the claim. As such, claim 2 recites an element to be afforded patentable weight, and it is respectfully submitted that the Examiner reconsider and withdraw the rejection of claim 2.

For at least similar reasons, it is respectfully submitted that claim 3, which recites that "the solvent comprises a biodegradable and water dilutable solvent designed for the removal of residual paints," be afforded patentable weight as not being drawn to an intended use of the invention. As such, it is respectfully submitted that Yamamoto further does not disclose or suggest the invention of claim 3.

#### **REJECTIONS UNDER 35 U.S.C. §103:**

On pages 5-8 of the Office Action, the Examiner rejects claims 1-4 and 8-11 under 35 U.S.C. §103(a) in view of Ihringer (U.S. Patent No. 4,407,316) and Yamamoto. The rejection is respectfully traversed and reconsideration is requested.

On page 6 of the Office Action, the Examiner admits that Ihringer does not disclose a filter for each of a washing system and a recycling system. In order to cure this deficiency, the Examiner relies upon the strainer 32 of Yamamoto since Yamamoto teaches that the strainer 32 can remove particles over 2 to 3 mil. However, as noted above, Yamamoto only suggests using one filter when the recycling apparatus is *not* incorporated into the parts washer (i.e, in FIG. 1 of Yamamoto). As such, Yamamoto does not suggest using the strainer 32 in a system such as that shown in Ihringer, which incorporates distillation columns into a cleaning installation and therefore removes paint from the solution using these distillation columns (and specifically collects the paint into a bottom of a mixer 11 as described in col. 2, lines 20-30 of Ihringer).

Moreover, since Ihringer relies upon distillation columns, Ihringer does not suggest a need for using a filter in a recycling system at all. Therefore, Ihringer does not suggest using filters in either or both of the washing system and the recycling systems as defined by the Examiner. As such, even assuming arguendo that Yamamoto suggests including a filter in a washing system, Yamamoto does not suggest using the filter in the recycling system in addition to a washing system, and does not suggest using a filter in a recycling system having distillation columns as described in Ihringer. Therefore, the combined teachings of Yamamoto and Ihringer would not result in a washing system and recycling system having filters as recited in claim 1.

In contrast, claim 1 recites, among other features, "a washing system which is connected to the reservoir and to the basin such that the solvent from the reservoir is moved past a first filter to remove portions of the paint and/or the related spray coatings in the solvent" and "a recycling system which is connected to the reservoir and to the basin such that the solvent from the reservoir is moved past a second filter to remove portions of the paint and/or the related spray coatings in the solvent." As such, it is respectfully submitted that the combination does not disclose or suggest the invention of claim 1.

Further, Yamamoto teaches away from the purely integrated system shown in Ihringer since "a difficulty with this arrangement is that the parts washer cannot be used while the solvent is going through the recycling process" and since "if a breakdown occurs during the recycling process, the parts washer is out of commission totally until the recycling apparatus is repaired." (Col. 1, lines 44-49). On page 16 of the Office Action, the Examiner asserts that col. 1, lines 44-49 of Yamamoto does not disclose Yamamoto's invention. However, this passage of Yamamoto is not relied upon as a teaching for Yamamoto, but instead as a reason why one of ordinary skill in the art would not utilize a system such as Ihringer, which has a purely integrated system having a common pump 4 to pump solvent through conduits 6 and 21 having the problem

described in Yamamoto. Thus, this passage teaches to not use a system such as that used by Ihringer, and instead to replace the system of Ihringer with those systems proposed in Yamamoto. There is no suggestion in the record as to why such a combination should be made, or an explanation or evidence which explains why a person of ordinary skill in the art would utilize all features of Ihringer except for those features relied upon by the Examiner as being disclosed in Yamamoto, such as the strainer 32, or why a filter would be used at all in a distillation column based recycling system as described in Ihringer, when Yamamoto specifically discourages the use of a device such as that shown in Ihringer, and there is no apparent technological need for multiple strainers in Ihringer. Without such evidence of record to support the combination and explain the contrary teachings of Ihringer, there remains insufficient evidence to maintain a prima facie obviousness rejection of claim 1.

In addition, Ihringer describes the use of a particular solvent: 2-N-methyl-pyrrolidone. There is no suggestion that 2-N-methyl-pyrrolidone includes the features of the solvent recited in claims 2 and 3. To the extent that the Examiner relies upon 2-N-methyl-pyrrolidone inherently having each feature of claims 2 and 3, it is respectfully requested that the Examiner provide evidence that 2-N-methyl-pyrrolidone necessarily includes each and every feature of the claimed solvent. Additionally and as noted above, Yamamoto discloses that the solvent 22 can be petroleum or water based. However, there is no suggestion as to the type of solvent, whether the solvent is both aqueous based as well as having other properties, or that the solvent in either Ihringer or Yamamoto is biodegradable. Moreover, while the Examiner asserts, without support, that the combined device of Ihringer and Yamamoto may be capable of handling such solvents recited in claims 2 and 3, neither Ihringer nor Yamamoto specifically discloses the type of solvents.

On page 16 of the Office Action, the Examiner clarifies that the type of solvent relates to merely an intended use of recited invention. However, as noted above, claims 2 and 3 are not recited as an intended use but positively recite the solution as an element of the claim. In contrast and as described above, claim 2 recites, among other features, that "the solvent comprises an aqueous, Hazardous Pollutants (HAPs) free, low VOCs (volatile organic compounds), non-flammable, non-toxic, non-carcinogenic, solvent." Further claim 3 recites that "the solvent comprises a biodegradable and water dilutable solvent designed for the removal of residual paints." As such, it is respectfully submitted that these solvents are positively defined and should be afforded patentable weight. Therefore, it is respectfully submitted that the combination does not disclose or suggest the invention of claims 2 and 3.

For at least similar reasons, it is respectfully submitted that the combination does not disclose or suggest the invention of claims 10 and 11.

Also, the Examiner relies upon the pump 4 of Ihringer as disclosing a control system which selectively moves the solvent as recited in claim 4. By way of review, claim 4 recites, among other features, that "the control system further comprises a pump which selectively moves the solvent from the reservoir through the washing system and the recycling system." However, Ihringer teaches the pump 4 pumps the 2-N-methyl-pyrrolidone solvent from the receptacle 3 through a feed conduit 21 to the nozzles 2, and, using a branch conduit 6, to a fractional distillation column 7. There is no indication as to how the pump 4 is integrated into a control system or how the pump 4 selectively acts to pump the 2-N-methyl-pyrrolidone solvent into the feed conduit 21 and/or the branch conduit 6. While the Examiner asserts on page 17 of the Office Action that the automation of a manual activity does not confer patentability, to rely upon such a holding, the Examiner must first point out which manual activity is being relied upon. In this instance, Ihringer does not disclose, and the Examiner does not explain, how the pump 4 is able to pump fluid selectively through conduits 6 and 21 when no mechanism, manual or otherwise, allows for such selectivity. Since Yamamoto is not relied upon as disclosing such a feature, it is respectfully submitted that the combination does not disclose or suggest the invention of claim 4.

Similarly, since the pump 4 cannot control the flow of the 2-N-methyl-pyrrolidone solvent, the Examiner acknowledges that Ihringer does not suggest that controlling the 2-N-methyl-pyrrolidone solvent to pass through one filter as opposed to another filter. In order to cure this deficiency, the Examiner relies upon Yamamoto. However, as noted above, Yamamoto does not suggest using dual filters. Specifically, to the extent that a strainer 32 is used, Yamamoto specifically suggests that the recycling apparatus (not shown) is detachable such that no single control system controls the flow into the strainer 32 as opposed to into the independent recycling apparatus. Further, where the recycling apparatus 122 is used, there is no strainer 32. As such, there is no suggestion in either Ihringer or Yamamoto that the "the control system further comprises a pump which selectively moves the solvent from the reservoir through the washing system and the recycling system" and that the "first filter is other than the second filter such that, during the washing operation, the control system controls the solvent to pass through the first filter but to not pass through the second filter" as recited in claim 8.

Further, to the extent that the recycling system 122 is operated intermittently by the microprocessor circuit board 85, Yamamoto operates the pump 38 while the recycling apparatus

122 is operating. Thus, Yamamoto does not disclose not operating the pump 38 while operating the recycling system 122, or that there would be an advantage in so doing. Since Ihringer is not relied upon as disclosing such a feature, it is respectfully submitted that the combination does not disclose or suggest, among other features, that "the first filter is other than the second filter such that, during the recycling operation, the control system controls the solvent to pass through the second filter" as recited in claim 9.

On page 17 of the Office Action, the Examiner clarifies that the Ihringer can be broadly interpreted to selectively move the solvents in col. 2, lines 5-9 from the washing system to the recycling system to meet the limitations of claim 9 since claim 9 does not recite that the solvent passes through the second filter but not through the first filter. As a point of clarification, claim 9 depends from claim 8 which recites, among other features, that "during the washing operation, the control system controls the solvent to pass through the first filter but to not pass through the second filter." Thus, claim 9 further recites that, in addition to being able to control the solvent to not pass through the second filter during the washing operation, "during the recycling operation, the control system controls the solvent to pass through the second filter." Ihringer does not broadly describe such a combination and indeed, the conduits 6 and 21 lack any mechanism providing for such a selective flow control operation. As such, it is respectfully submitted that the combination does not disclose or suggest both forms of selectivity in a manner corresponding to the invention as recited in claim 9.

On pages 8-9 of the Office Action, the Examiner rejects claims 5, 12 and 15 under 35 U.S.C. §103(a) in view of Ihringer, Yamamoto, and Ozyjiwsky (U.S. Patent No. 5,107,876). The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's construction of Ihringer, Yamamoto, and Ozyjiwsky is correct and that the combination is otherwise proper, the Examiner does not rely upon Ozyjiwsky to cure the above noted deficiency of the combination of Ihringer and Yamamoto as applied to claim 4, from which claims 5, 12, and 15 depend. As such, it is respectfully submitted that the combination does not disclose the features of claims 5, 12, and 15.

On pages 9-10 of the Office Action, the Examiner rejects claims 6, 16 and 20 under 35 U.S.C. §103(a) in view of Ihringer, Yamamoto, and Robb et al. (U.S. Patent 4,793,369). The rejection is respectfully traversed and reconsideration is requested.

On page 17 of the Office Action, the Examiner asserts that Robb et al. teaches a different way of aligning containers and that "both are expected to be used with predictable



degrees of success." As such, and in partial reliance on *KSR International Co. v. Teleflex Inc.*, 127 S.Ct 1727, 82 USPQ2d 1385 (U.S. 2007), the Examiner asserts that the combination is obvious since both elements were known and there was no change in their respective functions. However, it is respectfully submitted that in cases such as *KSR*, the record is replete with explanations and evidence as to why one skilled in the art would have made a particular combination. This requirement for finding a factual basis for such conclusions was further emphasized in the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*", which found that "Factual findings made by Office personnel are the necessary underpinnings to establish obviousness." (72 Fed. Reg. 57527 (Wednesday, October 10, 2007)). This requirement is needed in order to enable a proper review under the Administrative Procedure Act, 5 U.S.C. §706. No such evidence is present in the Examiner's conclusory statement. Moreover, the Examiner has not explained why one skilled in the art, when faced with the specific criticism of Yamamoto of the system similar to that described in Robb et al., one would still utilize the system described in Robb et al. Unless such evidence is accounted for, the record remains deficient as to why the system in Yamamoto would be modified to incorporate the system described in Robb et al. in a manner meeting the claimed invention. In re Young, 18 USPQ2d 1089 (Fed. Cir. 1991) cited by MPEP 2143.01. As such, in view of the record as a whole, it is respectfully submitted that there is insufficient evidence supporting a need to combine the references in a manner in which "the basin further comprises an inlet and a grate disposed above the inlet and a bottom surface of the basin, the reservoir is defined between the bottom surface and the grate, and the pump removes the solvent from the reservoir through the inlet during the washing operation and the recycling operation" as recited in claim 6.

Since Robb et al. is not relied upon as curing the above noted deficiencies of Ihringer and Yamamoto as applied to claim 1, claims 16 and 20 are deemed patentable over the combination due at least to their depending from claim 1.

On page 11 of the Office Action, the Examiner rejects claim 7 under 35 U.S.C. §103(a) under 35 U.S.C. §103(a) in view of Ihringer, Yamamoto, and Penguin™ Filter Pump Industries and Perez et al. (U.S. Patent 5,947,057).

Even assuming *arguendo* that the Examiner's construction of Ihringer, Yamamoto, and Penguin™ Filter Pump Industries and Perez et al. are correct and that the combination is otherwise proper, the Examiner does not rely upon Penguin™ Filter Pump Industries and Perez et al. to cure the above noted deficiency of the combination of Ihringer and Yamamoto as

applied to claim 4, from which claim 7 depends. As such, it is respectfully submitted that the combination does not disclose the features of claim 7.

On pages 12-13 of the Office Action, the Examiner rejects claims 13, 14 and 17 under 35 U.S.C. §103(a) in view of Ihringer, Yamamoto, Ozyjiwsky, and Robb et al. The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's construction of Ihringer, Yamamoto, Ozyjiwsky, and Robb et al. are correct and that the combination is otherwise proper, the Examiner does not rely upon Robb et al. to cure the above noted deficiency of the combination of Ihringer, Yamamoto, and Ozyjiwsky as applied to claim 12, from which claims 13, 14, and 17 depend. As such, it is respectfully submitted that the combination does not disclose the features of claims 13, 14 and 17.

On page 13 of the Office Action, the Examiner rejects claim 18 under 35 U.S.C. §103(a) in view of Ihringer, Yamamoto, Ozyjiwsky, and Magliocca (U.S. Patent No. 6,398,877). The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's construction of Ihringer, Yamamoto, Ozyjiwsky, and Magliocca are correct and that the combination is otherwise proper, the Examiner does not rely upon Magliocca to cure the above noted deficiency of the combination of Ihringer, Yamamoto, and Ozyjiwsky as applied to claim 12, from which claim 18 depends. As such, it is respectfully submitted that the combination does not disclose the features of claim 18.

On page 14 of the Office Action, the Examiner rejects claim 19 under 35 U.S.C. §103(a) in view of Ihringer, Yamamoto, Ozyjiwsky, Magliocca and Robb et al. The rejection is respectfully traversed and reconsideration is requested.

Even assuming arguendo that the Examiner's construction of Ihringer, Yamamoto, Ozyjiwsky, Magliocca and Robb et al. are correct and that the combination is otherwise proper, the Examiner does not rely upon Robb et al. to cure the above noted deficiency of the combination of Ihringer, Yamamoto, Ozyjiwsky, and Magliocca as applied to claim 18, from which claim 19 depends. As such, it is respectfully submitted that the combination does not disclose the features of claim 19.

Further, for reasons similarly set forth above in relation to the rejection of claim 6, in view of the record as a whole, it is respectfully submitted that there is insufficient as to why the references would be combined in a manner in which "the basin further comprises an inlet and a

grate disposed above the inlet and a bottom surface of the basin, the reservoir is defined between the bottom surface and the grate, and the pump removes the solvent from the reservoir through the inlet during the washing operation and the recycling operation" as recited in claim 19.

**CONCLUSION:**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

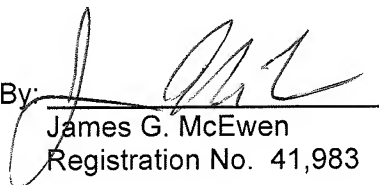
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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